

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-PETER JALET, FELIX SPINDLER,
HANS-ULRICH BLASER and REINHARD GEORG HANREICH

Appeal No. 2001-0421
Application 08/926,835

ON BRIEF

MAILED

FEB 27 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WILLIAM F. SMITH, GARRIS, and POTEATE, Administrative
Patent Judges.

Per curiam.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1-37, which are all of the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A process for the hydrogenation of an imine with hydrogen under elevated pressure in the presence of an iridium catalyst and with or without an inert solvent, wherein the reaction mixture contains an ammonium chloride, bromide or iodide, or a metal chloride, bromide or iodide that is soluble in the reaction mixture, and additionally contains an acid.

The references relied on by the examiner are:

Blackborow et al. (Blackborow)	5,103,061	Apr. 7, 1992
Osborn et al. (Osborn)	5,112,999	May 12, 1992
Petit et al. (Petit)	5,210,202	May 11, 1993
Burk	5,426,223	Jun. 20, 1995

Chao et al. "Enantioselective Synthesis of Optically Active Metolachlor via Asymmetric Reduction." Tetrahedron Asymmetry, vol 3, no. 3, pp 337-340, 1992.

GROUND OF REJECTION

1. Claims 1-35 stand rejected under 35 U.S.C. § 102(b) as anticipated by Osborn.

2. Claims 1-37 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Osborn, Burk, Petit, Blackborow and Chao.

We vacate the pending rejections and enter new grounds of rejection pursuant 37 CFR § 1.196(b).

DISCUSSION

The present invention is directed to a process for the hydrogenation of an imine with hydrogen in the presence of an iridium catalyst. Claims 1 and 36. Appellants' principal argument is that none of the cited references, alone or in combination, disclose or suggest "an iridium catalyzed hydrogenation reaction that **additionally contains an acid** as required by the present claims." See Appeal Brief, Paper No. 14, received September 29, 1998, page 3, paragraph (8)(a). In this regard, appellants further explain that "additional use of an acid in the context of the instant invention means an **aqueous acidic solution**." Reply Brief, Paper No. 16, received January 15, 1999, page 1, paragraph (1).

The examiner has taken the position that the prior art teaches an in situ acid. In particular, the examiner maintains that the "sulfonic group in column 1, lines 55-60 [of Osborn], reads on the claimed acid." Examiner's Answer, page 4, paragraph (11). The examiner further notes that the Petit reference discloses a starting compound that is itself an acid. *Id.*, page 5, paragraph (11).

During patent examination, the PTO gives claim language its "broadest reasonable interpretation." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In general, the terms in a patent claim are given their ordinary meaning as used in the field of the invention unless the text of the patent indicates that a word has special meaning. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001). A patentee may be his own lexicographer provided that he sets forth an explicit definition for a claim term in the patent specification. *Id.*

Claim 1 recites "[a] process for the hydrogenation of an imine . . . wherein the reaction mixture . . . additionally contains an acid." (Emphasis added.) The specification is limited to the following explanation regarding the use of an acid in the claimed process: "[t]he process according to the invention further comprises the additional concomitant use of an acid. It may be an inorganic or, preferably, an organic acid." Specification, page 18, second full paragraph. In our view this language does not indicate that appellants intended to assign any special meaning to the aforementioned claim language. Thus, the claims must be interpreted based on their ordinary meaning.

At the outset, we note that our consideration of this appeal has been hampered by the prosecution history. The first Office action in this case was a final rejection. See Paper No. 10, mailed December 22, 1997. Therein, the examiner did not make any explicit findings in regard to that aspect of the claimed subject matter requiring "additionally contains an acid." In responding to the final rejection, appellants argued that Osborn is "totally silent on the use of an acid in the process described therein." Request for Reconsideration, Paper No. 12, received May 26, 1998.

The examiner argued in the Advisory Action (Paper No. 13, mailed June 3, 1998) that "Osborn et al, column 1, line 55-57, Burk et al, example, and Chao et al, page 338, expressly teach acid in the hydrogenation reaction." Appellants disputed the allegation in regard to Osborn arguing, "the disclosure of $-SO_3H$ as a substituent of the disphosphine ligand of the iridium catalyst does not constitute a disclosure of an iridium catalyzed hydrogenation reaction that 'additionally contains an acid.'" Appeal Brief, page 3.

Surprisingly, in stating the rejection in the Answer, the examiner still did not make any explicit findings in regard to this aspect of the claimed subject matter. Rather, the only mention of this claim requirement is the examiner's comment on

page 4 of the Answer that "[a]s to the specific acid, sulfonic group in column 1, lines 55-60, reads on the claimed acid."

As the record stands, neither the examiner nor appellants have adequately explained their positions as to the metes and bounds of the claim requirement that the reaction "additionally contain an acid." In our view, the examiner and appellants would be hard-pressed to provide such explanation due to the manner in which claim 1 is drafted. As written, claim 1 does not provide for active, positive method steps. Instead, claim 1 describes a "reaction mixture" which is presumably to be used "for the hydrogenation of an imine."¹ It may be that the examiner and appellants have redrafted the claim in their minds to provide the needed active steps, e.g., "providing a reactive mixture containing X and Y," "reacting X with Y" etc. in formulating their respective positions. But without the examiner and appellants setting forth **on the record a fact-based explanation** in support of their claim construction, we have, in effect, nothing to review.²

¹ Note that there is no antecedent support for the phrase "**the** reaction mixture" in claim 1.

² This Board serves as a Board of review, not a **de novo** examination tribunal. 35 U.S.C. § 6(b) ("the [Board] shall, on written appeal of an applicant, review adverse decisions of

These shortcomings aside, our review of the matter leaves us in a quandary as to how to interpret the claims. According to the examiner, the broadest reasonable interpretation of claim 1 includes both the in situ formation of an acid as well as the addition of an exogenous acid. According to appellants, the phrase "additionally contains an acid" should be interpreted as limited to the addition of an exogenous acid. We cannot say that the specification clearly supports either the appellants' or the examiner's interpretation.

As noted above, the specification does not use explicit language which supports appellants' proposed interpretation of the claims. However, the examples are limited to the addition of an exogenous acid. There is no antecedent support for "**the** reaction mixture." As to the claim reciting positive, active method steps, one can only guess how to implement the "additionally contain an acid" proviso of the process claims. In sum, it is apparent that a material issue of claim interpretation is present which must be resolved before the merits of the examiner's and the appellants' positions can be properly considered.

examiners upon applications for patents").

All of this leads us to conclude that the fundamental problem in this case is that the claims are indefinite. Under these circumstances, it is appropriate for us to vacate the examiner's prior art rejection in view of our new ground of rejection under 35 U.S.C. § 112, second paragraph.

NEW GROUND OF REJECTION

Under the provisions of 37 CFR § 1.196(b) we enter the following new ground of rejection:

Claims 1-37 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinguish claimed the invention.

Claims 1-37 are indefinite in that, while purporting to be drawn to processes, they fail to set forth any discernable method steps.³ The claims should actively recite the steps of adding

³ Other cases where similar claims have been involved are **Ex parte Erlich**, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986) (non-precedential) (citations omitted) ("While . . . the claims need not recite all of the operating details, we do find that a method claim should at least recite a positive, active step(s) so that the claim will 'set out and circumscribe a particular area with a reasonable degree of precision and particularity,' and make it clear what subject matter [the] claims encompass, as well as making clear the subject matter from which others would be precluded.") and **Anglo-American Extrusion Co. v. Ladd**, 226 F. Supp. 295, 300, 140 USPQ 304 (D.D.C. 1964) (holding that claim "recit[ing] a method which is defined not by positive method

each of the individual components of the reaction mixture. If appellants intend to claim addition of an exogenous acid as opposed to in-situ formation of an acid, then the claims should include the step of adding the acid to the reaction mixture. Failure to use positive steps in claim 1 adds needless ambiguity to the claim. For example, as noted, the claim does not provide antecedent support for the phrase "the reaction mixture."

It is well established that "definiteness of [claim] language employed must be analyzed, not in a vacuum, but always in light of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Section 112, second paragraph, requires that: (1) the claims set forth what "the applicant regards as his invention" and (2) the claims be sufficiently "definite." *See Allen Eng'g Corp. v. Bartell Indus. Inc.*, 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1775 (Fed. Cir. 2002) (quoting *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377, 55

steps but by an indefinite result" was unpatentable under 35 U.S.C. § 112, second paragraph). *See generally* MPEP § 2173.05(q) (8th ed., Aug. 2001).

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USPQ2d 1279, 1282 (Fed. Cir. 2000) (quoting 35 U.S.C. § 112, second paragraph)).

"When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art." **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). "[I]f the claims do not 'particularly point out and distinctly claim[]', in the words of section 112, that which examination shows the applicant is entitled to claim as his invention, the appropriate PTO action is to reject the claims for that reason." **Id.**

(citing, *inter alia*, **In re Prater**, 415 F.2d 1393, 1404, 162 USPQ 541, 550-51 ("claim that reads on subject matter beyond the applicant's invention fails to comply with 35 U.S.C. § 112"))).

Given the varying claim interpretations of the examiner and appellants, it is apparent that the claims do not particularly point out and distinctly claim the invention. It does not appear that one skilled in the art would be able to determine whether the claims are limited to (1) the addition of an exogenous acid, (2) in situ formation of an acid or are intended to encompass both manners of providing the stated acid since the claims do not

recite positive, active steps, e.g., "adding an acid," "forming an acid in situ" etc. Therefore, one of ordinary skill in the art would not be capable of determining the metes and bounds of the claims even when read in light of the specification. **See Allen**, 299 F.3d at 1348, 63 USPQ2d at 1775 (quoting **Personalized Media Communications, LLC v. Int'l Trade Comm'n**, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998)) ("In determining whether the claim is sufficiently definite, we must analyze whether 'one skilled in the art would understand the bounds of the claim when read in light of the specification.'")

Therefore, we reject claims 1-37 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. **See Allen**, 299 F.3d at 1349, 63 USPQ2d at 1776 (citing **Zletz**, 893 F.2d at 322, 13 USPQ2d at 1322 (claims which do not particularly point out and distinctly claim what the inventor regards as his invention must be rejected under Section 112, second paragraph)). **See Zletz**, 893 F.2d at 321, 13 USPQ2d at 1322 (citations omitted) ("[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.")

In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process." **Panduit Corp. v. Dennison Mfg. Co.**, 810 F.2d 1561, 1567-58, 1 USPQ2d 1593, 1597 (Fed. Cir.), **cert. denied**, 481 U.S. 1052 (1987). Where a reasonable interpretation of the claims cannot be made, it follows that it is impossible to compare the claimed invention with the prior art. **See Graham v. John Deere Co.**, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) ("Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.")

In order to consider the merits of the Examiner's rejection, we would first have to compare the claimed subject matter with the relevant prior art which would necessarily require that we speculate or make assumptions as to what is intended by the claims. Thus, we have decided to vacate the examiner's rejection and enter a new ground of rejection under 37 CFR § 1.196(b).

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See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and **In re Wilson**, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

RESPONSE TO THE SEPARATE OPINION

Our colleague states that we have acted "improperly and irresponsibly" (slip op., page 33) by taking actions today which he believes are "wholly inappropriate." Slip Op., page 22. In addition, our colleague accuses us of establishing a **per se** rule. Slip Op., pages 31-32. We disagree.

As explained, the lack of positive steps in claim 1 renders that claim indefinite under 35 U.S.C. § 112, second paragraph. The court stated in **Zletz, supra**, "[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed." This is exactly the outcome of the actions we take today.

In ***Allen Engineering***, supra, the court stated:

We are simply tasked with determining whether the claims "particularly point[] out and distinctly claim[]" what the inventor regards as his invention. 35 U.S.C. §112, paragraph 2; see also *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (holding that claims failing this test during prosecution must be rejected under §112, paragraph 2). Moreover, it is of no moment that the contradiction is obvious: semantic indefiniteness of claims "is not rendered unobjectionable merely because it *could* have been corrected." *In re Hammack*, 427 F.2d 1384, 1388 n.5, 166 USPQ 209, 215n.5 (CCPA 1970).

We have performed that task and determined the claims on appeal are indefinite. In our view, the best course of action is to raise this issue in the context of a new ground of rejection under the provisions of 37 CFR § 1.196(b). Contrary to the views of our colleague, our actions today will provide a forum for appellants and the examiner to expeditiously close prosecution of the case, at least on the record before us.

This is seen in that appellants argue in this appeal that "additional use of an acid in the context of this invention means an aqueous acidic solution." Making arguments in an appeal proceeding on the basis of "the context of this invention" instead of the actual claim language used is unhelpful in resolving the patentability issues since patentability is premised upon the claims not an "invention." In similar manner,

the examiner's assertions in regard to the prior art purportedly teaching in situ acid formation are of little help absent a thorough construction of the claims under review and explanation why the purported teachings of the references are relevant to the claims as construed.

It is clear that prior to our decision today appellants and the examiner were content to argue their respective positions absent meaningful claim construction. After today, they cannot so proceed. Rather, they must confront the ambiguous claim language and move forward. It may be that appellants understand their invention to be directed to exogenous acid addition to the "reaction mixture" as argued in this appeal instead of in situ formation of an acid as the examiner believes is suggested by the applied prior art. If so, the posture of the case as of today permits appellants to clarify the noted ambiguous language and claim what they regard to be their invention in accordance with 35 U.S.C. § 112, second paragraph. If appellants submit such an amendment, the examiner will have to reconsider the patentability of the claims in light of all relevant prior art.

We decline to impose our own version of the scope of the claims in the context of this appeal proceeding as our colleague would prefer since the claims are before the USPTO and are now

subject to amendment. The more reasonable course of action, given the lack of an effective exchange of views between appellants and the examiner in regard to claim construction, is to allow appellants the opportunity to consider the issues raised herein and decide how they want to define their invention. After all it is their invention, not ours.⁴

We will comment on our colleague's willingness to excoriate our decision while failing to assign any responsibility for the state of the record presented to us for review in this appeal to appellants and the examiner. Claim 1 has not been amended since it was filed as part of the original disclosure in the parent application. As outlined above, the issue of the meaning of the term "and additionally contains an acid" as used in claim 1 has never been meaningfully explored by appellants and the examiner. Indeed, as noted the examiner does not even discuss this aspect of claim 1 in stating his rejections in the answer. The messenger should not be harmed for telling appellants and the examiner to pay closer attention to claim scope during the administrative examination process.

⁴Imposition of a claim construction by a merits panel during an appeal before this Board is not without its own peril. **See In re Priest**, 582 F.2d 33, 37-38, 199 USPQ 11, 15 (CCPA 1978).

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Appellants and the examiner are responsible for the record they forward to the Board and it is the responsibility of the assigned merits panel to review the examiner's adverse decision on the basis of that record. Not every record forwarded to the Board is susceptible to meaningful review. Prior to pursuing an appeal or writing an Examiner's Answer, appellants and the examiner should respectively take a step back from the case and objectively view the record and ensure that their position is susceptible to meaningful review. A hallmark of such a record is a reasoned exchange of views as to claim construction, especially those aspects of the claims where the patentability issues lie. This did not happen in this case

Nor do we find the fact that appellants, the examiner and appeal conferees did not consider claim 1 to be ambiguous to mean that the claim is definite under 35 U.S.C. § 112, second paragraph. The provision of an administrative appeal within the agency as well as the provisions of 37 CFR § 1.196(b) in regard to the Board making new grounds of rejection presuppose that appellants and the examiner, as well as reviewers or conferees in the Examining Corps, may overlook or misapprehend reasons relevant to the patentability of the pending claims. The lack of a rejection by the examiner is not controlling on the issue.

We also take the opportunity to state that we are **not** making a **per se** rule in regard to any specific claim language. We only hold that the language used in claim 1, considered in the context of the present record, is ambiguous and thus, indefinite. Whether claims of similar format presented in a different case meet the requirements of 35 U.S.C. § 112, second paragraph, will have to be decided upon the facts of that case. The cases our colleague cites at best provide further background as to the issues we have raised. None are controlling either way.

Our colleague declines to express his views on the pending prior art rejections because, in his view, to do so would be an advisory opinion. This view is interesting since it is difficult to discern how a dissenting opinion in and of itself is anything but an advisory opinion. If our colleague would provide his construction of claim 1 and with that construction in mind how he would propose to decide the pending rejections, we would have a basis to agree or disagree. Each of us is willing to listen and be persuaded and it would only require a single changed vote to transform the dissenting viewpoint to the majority. Regretfully, our colleague has declined to do so.

Our colleague's reticence to express his views on the merits is puzzling also in that he has invited appellants and the

examiner to pursue extraordinary relief in response to our actions today. Yet, he has not provided appellants any assurance that they even have his vote on the issues as they are presented on the existing record. Why should appellants expend their time and resources in pursuit of the suggested relief only to discover that they never had a single vote on the panel?

Our colleague's actions appear to indicate his belief that he can or should only react to what the majority has decided and written in its supporting opinion. We do not believe that to be the case. Each member of the panel has an independent vote on the issues presented and any panel member may write separately to express his or her views on a matter as our colleague does here. Stating his view that claim 1 is broad, not indefinite, does not provide a sufficient claim construction so that the prior art can be properly applied.

Nor do we find our colleague's view that claim 1 is susceptible to only two interpretations to be controlling. Assuming that to be the case, we do not find it sufficient to mandate imposition of a specific construction at this point in time. We do not have a record from which we can choose or receive guidance from a well reasoned exchange of views between appellants and the examiner as to claim construction and

subsequent application of the prior art. We did not create this state of affairs, appellants and the examiner did. Since the claims can still be amended, we believe the actions we take today are entirely appropriate and proper and represent the most expeditious way to achieve a prompt resolution of the patentability issues presented in this appeal.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

VACATED; 37 CFR § 1.196(b)


WILLIAM F. SMITH

Administrative Patent Judge



LINDA R. POTEATE

Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

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BRADLEY R. GARRIS, ***Administrative Patent Judge***, dissenting.

I dissent from the action taken by the majority on this appeal whereby the examiner's prior art rejections have been vacated and a new rejection under the second paragraph of 35 U.S.C. § 112 has been made.

These actions are wholly inappropriate for a variety of reasons. First, the majority's section 112 position is without merit. Second, even assuming the majority's section 112 concerns are valid, the circumstances of this case are such that the examiner's prior art rejections should be reviewed on the merits. Third, the actions of the majority on this appeal militate against the missions and goals of the U.S. Patent and Trademark Office by exacerbating the pendency problems which are so widely recognized as plaguing this agency and its customers. These several reasons are expounded upon more fully below.

THE MAJORITY'S SECTION 112, SECOND PARAGRAPH,
REJECTION IS WITHOUT MERIT

The rejection is not supported by cited authority

Concerning their new rejection under the second paragraph of section 112, the majority panel members state "[c]laims 1-37 are indefinite in that, while purporting to be drawn to processes, they fail to set forth any discernable method steps." Slip Op.,

page 8. It is their view that "[t]he claims should actively recite the steps of adding each of the individual components of the reaction mixture." *Id.*, pages 8-9. In expressing this view, the majority refers to *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Int. 1986), *Anglo-American Extrusion Co. v. Ladd*, 226 F. Supp. 295, 300, 140 USPQ 304, 308 (D.D.C. 1964) and the Manual of Patent Examining Procedure (MPEP) § 2173.05(q) (8th ed., Aug. 2001).

These citations do not support the majority's new rejection under the second paragraph of section 112.

The majority expressly characterizes *Ex parte Erlich* (which was authored by one of the majority panel members) as non-precedential. By its very nature, a non-precedential opinion does not and cannot provide legal support for this rejection. In addition, the indefiniteness issues discussed in *Erlich* and in MPEP § 2173.05(q) involve claims directed to processes for using a material without reciting any steps as to how the use is actually practiced. Contrastingly, the appealed claims are directed to processes for reacting an imine and hydrogen with specific and considerable information as to how this reaction is actually practiced. While possibly applicable to "process of

using" claims, the rationale in **Erlich** and in MPEP § 2173.05(q) certainly is not applicable to "process of making" claims of the type before us on this appeal.

In fact, these appealed claims are analogous to the "process of making" claims involved in **Ex parte Bull**, 117 USPQ 302 (PTO Bd. App. 1957), which the **Erlich** panel considered inapposite because the claims of **Bull** "did recite active, positive steps such as 'bringing together . . .'" **Erlich**, 3 USPQ2d at 1017. It is appropriate to clarify that **Bull's** claim recitation "bringing together . . ." relates to the ingredients of his reaction mixture without specifying how these ingredients were caused to be in the reaction mixture. Plainly, this claim recitation is not conceptually different from the appellants' claim recitation of reaction mixture ingredients without specifying how these ingredients were caused to be in the reaction mixture. It is a mystery how the majority panel member of this appeal, who authored the **Erlich** opinion, could rationally consider the claims here on appeal to offend the second paragraph of section 112 and yet consider the conceptually indistinguishable claims of **Bull** to comply with this paragraph.

The case of **Anglo-American Extrusion Co. v. Ladd** also does not support the majority's section 112 position. It is true that this case held a method claim to be indefinite. Few details are apparent regarding this claim since it was not reproduced. Nevertheless, it is reasonably clear that the holding was based on the fact that the method claim was considered indefinite because it recited "an indefinite result [wherein] [t]hat result is set forth as a product 'comparable to' the definitely described product of a definitely recited method." **Id.**, 226 F. Supp. at 300, 140 USPQ at 308. Because the majority's concerns regarding the appealed claims do not involve such an indefinite result, the new section 112, second paragraph, rejection of these claims is not supported by **Anglo-American**.

Thus, the majority has proffered no legal authority in support of their specific rationale for considering the appealed claims to be indefinite. This is not surprising since there is no such authority. What I do find surprising and indeed troubling is the majority's belief that, "[g]iven the varying claim interpretations of the examiner and appellants, it is apparent that the claims do not particularly point out and distinctly claim the invention." Slip Op., page 10. Contrary to

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the majority's belief, the test for determining compliance with the second paragraph of section 112 is not whether the examiner and the appellants agree or disagree in their interpretation of the appealed claims. Instead, the test is whether the claims, as interpreted by one possessing the ordinary level of skill in the art, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Moreover, this disagreement in claim interpretation between the examiner and the appellants is the ***raison d'être*** of the appeal under consideration. Therefore, it is an illogic of oxymoronic character for the majority to believe that this disagreement supports its refusal to consider the appeal.

I am also troubled by the fact that a substantial portion of the majority opinion is devoted to criticism of the manner in which the appellants and the examiner have prosecuted this application. As with all appeals, the prosecution history of this application, at least from the hindsight provided by appellate review, may be regarded as falling short of achieving a thorough crystallization and briefing of all issues engendered by the appeal. Nevertheless, any such imperfection in the prosecution history does not, in and of itself, support the

majority's position that the appealed claims are indefinite. These claims are statutorily presumed to comply with the second paragraph of section 112. They are not somehow rendered non-compliant by the silence of the appellants and the examiner regarding the specific claim-construction issues raised by the majority. This point cannot be gainsaid. Yet, I am concerned the majority panel members may have unwittingly allowed their section 112, second paragraph, rejection to be inappropriately driven by and based upon their desire for a more completely developed prosecution history. Certainly, this rejection is not otherwise explicable based on the facts and law here under consideration. While the desire for a well developed prosecution history is understandable, an attempt to achieve this desideratum via a meritless section 112 rejection is completely unacceptable.

The claims are broad not indefinite

As indicated earlier, the process claims on appeal recite considerable and specific information regarding the process defined thereby. For example, these claims specify the type of reaction involved in the process (i.e., a hydrogenation reaction), the ingredients involved in the reaction and a variety

of reaction conditions including pressure, temperature, concentration and molar ratio. Nevertheless, the majority holds that the appealed claims are indefinite under the second paragraph of section 112. The majority has given one and only one reasonably specific basis for this holding which is the fact that the claims do not actively and positively recite the steps which result in a reaction mixture containing the recited ingredients including the acid ingredient in particular⁴. As

⁴ At this point, it is necessary to express a caveat. As support for their section 112 position, the majority panel members have focused on the fact that the appealed claims do not actively and positively recite the steps which result in a reaction mixture which "additionally contains an acid." Independent claims 1 and 36. Nevertheless, the language of the majority opinion is such that other aspects of the appealed claims may well be considered by the majority panel members to raise indefiniteness issues. For example, at no less than 3 different locations in their opinion, the majority panel members indicate that the independent claim phrase "the reaction mixture" lacks antecedent basis. Slip Op., at pages 6, 7 and 9. If the majority believes this phrase offends the second paragraph of section 112, they are in error as no one with ordinary skill in this art would consider the phrase to be indefinite. As an additional example, the majority expressly states that "[t]he claims should actively recite the steps of adding each of the individual components of the reaction mixture." Slip Op., at pages 8-9; emphasis supplied. Thus, although the majority opinion focuses on the acid ingredient specifically, this express statement reflects that the majority panel members will maintain their indefiniteness position unless the appealed claims are amended to actively recite the steps of adding each and every one of the individual ingredients of the here claimed reaction mixture.

phrased by the majority, "[i]t does not appear that one skilled in the art would be able to determine whether the claims are limited to (1) the addition of an exogenous acid, (2) in situ formation of an acid or are intended to encompass both manners of providing the stated acid." Slip Op., page 10. This is incorrect.

As recognized (though not practiced) by the majority, the definiteness of claim language must be analyzed, not in a vacuum but, always in light of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. ***In re Moore***, 439 F.2d at 1235, 169 USPQ at 238.

In this regard, the appellants' specification discloses that their invention is based on the discovery that catalyst activity in processes of the type under consideration can be increased if the reaction mixture contains a halide and an acid. See the subject specification at, for example, page 1, penultimate paragraph. It is the presence of the halide and acid in the reaction mixture which effects the increased catalyst activity. There is absolutely no disclosure in the appellants' specification that the increased catalyst activity results from the particular manner by which these or any other ingredients are

caused to be present in the reaction mixture. Indeed, a number of reaction mixture ingredients, such as the iridium catalysts, are disclosed as being added exogenously or generated in situ.

Id., at the paragraph bridging pages 16 and 17.

As for the acid ingredient specifically, the appellants disclose no preference for the manner by which the acid is caused to be present in the reaction mixture. Instead, they generically teach that "[t]he process according to the invention further comprises the additional concomitant use of an acid." *Id.*, at page 18. While at least some of the specification examples indicate that the acid is added exogenously, it is important to stress that the appellants' specification contains no disclosure of a preference for how the acid is caused to be present in the reaction mixture. Presumably, this is because, as previously mentioned, it is the presence of the acid in the reaction mixture, rather than how it is supplied thereto, which yields increased catalyst activity in the appellants' claimed process.

In light of the above discussed specification disclosure, one with ordinary skill in this art would interpret the appealed claims as requiring that the process reaction mixture "contains an acid" (independent claims 1 and 36) without regard to the manner by which this requirement is achieved. This

interpretation is not only consistent with the specification disclosure but is also consistent with the aforequoted literal recitation of the appealed independent claims. Therefore, it is my determination that these claims are simply broad, not indefinite, with the respect to the manner by which the acid and other ingredients are caused to be present in the reaction mixture of the appellants' claimed process⁵. It is here necessary to remind the majority of the long settled legal principle that claim breadth is not indefiniteness. ***In re Gardner***, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970).

The majority has created and applied a ***per se*** rule

It is, of course, the initial burden of the Patent and Trademark Office to present a ***prima facie*** case of unpatentability. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For the above stated reasons, the majority has failed utterly to present a ***prima facie*** case that the appealed claims are unpatentable under the second paragraph

⁵ The majority panel members do not explain, and I do not independently perceive, their basis for concluding that the above discussed claim interpretation "does not provide a sufficient claim construction so that the prior art can be properly applied." Slip Op., at page 19.

of 35 U.S.C. § 112. This circumstance forces me to conclude that the majority has created and applied a **per se** rule for process claims wherein compliance with the second paragraph of section 112 depends solely on whether "discernable method steps" are "actively recite[d]" Slip Op., page 8. While administratively convenient, such a **per se** rule is a legally improper substitute for the thoughtful analysis required to assess section 112, second paragraph, compliance. **Compare In re Ochiai**, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

EVEN ASSUMING CLAIM INDEFINITENESS, THE EXAMINER'S PRIOR ART REJECTIONS SHOULD BE EVALUATED ON THE MERITS RATHER THAN VACATED

In support of their indefiniteness position, the majority panel members state "[i]t does not appear that one skilled in the art would be able to determine whether the claims are limited to (1) the addition an exogenous acid, (2) in situ formation of an acid or are intended to encompass both manners of providing the stated acid since the claims do not recite positive, active steps." Slip Op., pages 10-11. Concomitantly, in support of their vacatur determination, the majority panel members express the following rationale:

In order to consider the merits of the Examiner's rejection, we would first have to compare the claimed subject matter with the relevant prior art which would necessarily require that we speculate or make assumptions as to what is intended by the claims. Thus, we have decided to vacate the examiner's rejection and enter a new ground of rejection under 37 CFR § 1.196(b). **See *In re Steele***, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and ***In re Wilson***, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) [***Id.***, at pages 12-13].

As previously explained, the majority's indefiniteness position is without merit. However, even assuming that the appealed claims are indefinite, the majority has acted improperly and irresponsibly in vacating the examiner's prior art rejections. This is because the one and only reason given by the majority for this vacatur is that the majority would have to speculate or make assumptions regarding "whether the claims are limited to (1) the addition of an exogenous acid, (2) in situ formation of an acid or are intended to encompass both manners of providing the stated acid." ***Id.***, at page 10. Clearly, the degree of uncertainty presumed by the majority is extremely narrow in that it includes only two possible "manners of providing the stated acid." ***Id.*** Under these circumstances, the responsible course of action would be to evaluate the merits of the examiner's prior art rejections with respect to both of these

"manners of providing the stated acid." *Id.* See *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984) and MPEP § 2173.06 (8th ed. Aug. 2001).

The benefits of this last mentioned approach are transparent. It avoids the extraordinary inefficiencies of piecemeal examination and appellate review. This Board has been properly critical when an examiner has engaged in a piecemeal evaluation of issues during examination proceedings. *Ionescu*, 222 USPQ at 540. For the majority to now engage in this same piecemeal consideration of issues during appeal proceedings is more than hypocritical. It also significantly multiplies the inefficiencies of piecemeal patentability determination. The case before us is the perfect example of the devastating consequences of piecemeal review when performed at an appellate level as will be discussed more fully below.

THE MAJORITY'S ACTIONS MILITATE AGAINST THE MISSIONS AND GOALS OF THE U.S. PATENT AND TRADEMARK OFFICE

Of the many problems which currently face the Patent and Trademark Office, few if any are more publicly discussed and consequential than the ever growing problem of patent application pendency. It has been a subject of increasing concern by Members

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of Congress, present and past Directors of this agency as well as practitioners before the PTO bar. Like few others, this problem of increasing pendency has frustrated the missions and goals of the Patent and Trademark Office.

The above discussed actions by the majority compound this pendency problem and thereby militate against the missions and goals of this agency. It is important to emphasize that the claims before us on this appeal are identical to the claims first filed in the Patent and Trademark Office in 1995 via parent application Serial No. 08/532,779. Similarly, the rejections first applied against these claims in the parent application are identical to the prior art rejections now before us. By vacating these prior art rejections, the majority in effect additionally has vacated all the prosecution which has taken place since these appealed claims were first filed in 1995.

Moreover, by making their new section 112, second paragraph, rejection, the majority panel members compel the appellants to now address indefiniteness issues which implicitly neither the appellants nor the examiner (nor his conferring supervisory patent examiner) have ever considered applicable to the claims on appeal (and which certainly this dissenting panel member does not consider applicable to these claims). Further, the avenues by

which the appellants may seek to address these claim indefiniteness issues are not only very limited but also are potentially very costly in terms of time as well as money. A sad but conceivable outcome of the actions here taken by the majority is that (after considerable expenditures of time, effort and money) the majority's section 112 rejection ultimately is overcome with the consequence that at some distant point in the future the very same prior art rejections of the very same claims before us today are returned to the Board for an unnecessarily delayed review. An even more sad but conceivable outcome is that the appellants simply give up their attempt to obtain a patent on the here claimed invention, not due to the merits of patentability but rather, due to sheer exhaustion.

For the above stated reasons, the majority's actions are unnecessary and worse are antithetical to this agency's missions and goals in support of the patent system.

CONCLUSION

The majority's new rejection is legally unwarranted and its vacatur of the examiner's prior art rejections is completely unnecessary. There are no acceptable reasons in support of these actions and yet many well founded reasons in disfavor of them.

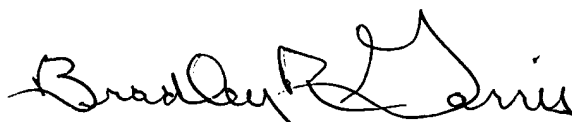
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The majority's actions are unique in that they have clearly undesirable consequences for both the appellants and the examiner (as well as the Examining Corps in general). Yet, a particularly frustrating aspect of these actions is that so few avenues exist by which the appellants and the examiner may seek review of them in a timely and efficient manner. One such avenue is by way of requests from both the appellants and the examiner for rehearing by an expanded panel of the Board. Though unusual, an expanded panel may be requested by appellants via, for example, a petition to invoke the supervisory authority of the Director (a.k.a. Commissioner) and/or to address a question not specifically provided for in the PTO regulations. See 37 CFR §§ 1.181 and 1.182 (2002). An examiner's request for rehearing of a Board decision must be approved by the Technology Center Director and must also be forwarded to the Office of the Deputy Assistant Commissioner for Patent Examination Policy for approval before mailing. See, for example, MPEP § 1214.04.

In summary, by their unwarranted actions taken in this appeal, the majority panel members have shirked their responsibility under 35 U.S.C. § 6 and have abused their authority under 37 CFR § 1.196(b). This circumstance can only be condemned. The majority panel members should fulfill their

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statutory responsibility under 35 U.S.C. § 6 by reviewing the examiner's prior art rejections of the claims on appeal. In the forum of this dissenting opinion, it would be inappropriate for me to express an advisory opinion concerning the merits of these prior art rejections. Therefore, I will defer expressing my view on these matters until such time as the majority members of this or an expanded panel are willing or required to review the examiner's prior art rejections of the appellants' long-pending claims.


BRADLEY R. GARRIS
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

BRG:tdl

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